



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/766,181	01/27/2004	Guido Bold	4-31321B	3696

1095 7590 12/22/2005

NOVARTIS
CORPORATE INTELLECTUAL PROPERTY
ONE HEALTH PLAZA 104/3
EAST HANOVER, NJ 07936-1080

EXAMINER

DAVIS, ZINNA NORTHINGTON

ART UNIT	PAPER NUMBER
----------	--------------

1625

DATE MAILED: 12/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/766,181	Applicant(s) BOLD ET AL.	
	Examiner Zinna Northington Davis	Art Unit 1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 7/14/05.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 19 and 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 and 21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>01/04</u> . | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

1. Claims 1-21 are pending.
2. In the response filed July 14, 2005, Applicants have elected Group I, claims 1-18 and 21. Examples 47 and 48 are the preferred species.
3. The search has been extended beyond the elected species. See below. Claims 1-18 and 21 are readable on the elected species. Claims 19 and 20 are withdrawn from consideration.
4. Applicants are reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).
5. Claims 1-18 and 21 are Markush claims, which are generic to the elected invention. These Markush claims lack unity of invention. Accordingly, the Markush type claim will be examined fully with respect to the elected species and further to the extent necessary to determine patentability. See MPEP 803.02.
6. Claims 1-18 and 21 are objected on the grounds that the claims are drawn to an improper Markush group. In re Harnish, 206 USPQ 300, states that a unity of invention exists where compounds included within a Markush group(1) share a common utility and (2) share a substantial structural feature disclosed as being essential to that utility. In the instant case, the claimed subject matter does not share a substantial structural

Art Unit: 1625

feature disclosed as being essential to that utility. See U. S. Patent 4,450,790. McGill et al. teach that 2-amino-5-alkyl pyridine compounds are useful as herbicides and insecticides. At columns 7 and 8, see Example No. 13.

The requirement for a proper Markush claim is that it includes only substances that in their physical, chemical and physiological characteristics are functionally equivalent. The members of the instant Markush groups possess widely different, physical and chemical properties. The compounds are not considered functionally equivalent and are so diverse that they demonstrate dissimilar and unrelated properties. The mere fact that there is structural similarity in pharmaceutical agents is not in itself reason to render all the embodiments functionally equivalent.

The improper Markush groups are A, B, T, D, E, G, X, and Y.

7. The examined subject matter is as follows:

A compound of formula I where X is $-NH$; G is CH_2 ; and the radicals, A, B, D, E, and T form an aromatic ring, Amending the claims to the examined subject matter would overcome the improper Markush rejection.

8. The examination was extended beyond the elected species. Accordingly, the following rejections are applicable.

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 1625

10. Claims 1-13, 17, 18, and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. At claims 1-3, 5, 6, 8-11, the phrase "R₁ und R₁" should be amended in favor of -R₁ and R₁--.

B. At claims 1-3, 5, 6-11, it is suggested that the term "characterized" should be amended to read as --wherein--.

C. At claim 4, penultimate line, the term "th" should be amended in favor of --the--.

D. At claim 11, page 84, last line, the term "methylen" should be amended in favor of --methylene--.

E. Claim 12 depends on multiple claims, which is improper.

F. At claims 13 and 16, it is suggested that the phrase "and salts" should be amended in the alternative --or a salt--.

G. Claim 17 is an essential duplicate of claim 1.

H. Claim 18 is improperly multiple dependent. Correction is appreciated.

I. At claim 21, the recitation of the terms "for example" and "preferably" is improper in U.S. practice.

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

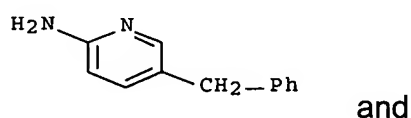
A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

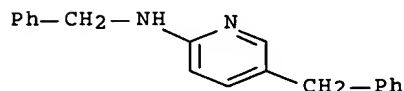
Art Unit: 1625

12. Claims 1, 2, and 17 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Kowalski (Reference U).

The instantly claimed compounds are disclosed. At page 248, see compounds 7 and 8. The claims are fully met when G is $-\text{CH}_2$; X is NH; and A, B, T, D, and E form a phenyl ring. See the structures below:



and



13. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double

Art Unit: 1625

patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

14. Claims 1-18 and 21 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims of U.S. Patent No. 6,706,731.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed subject matter overlaps. See the instant claims.

15. The Information Disclosure Statements filed January 27, 2004 have been considered.

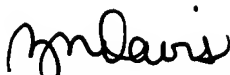
16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zinna N. Davis whose telephone number is 571-272-0682.

17. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300 for regular communications.

18. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

Art Unit: 1625

you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Zinna Northington Davis
Primary Examiner
Art Unit 1625

Znd
12.17.2005